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Dated: November 24, 2003

Signature:


Paul B. Stephens

Docket No.: 29020/97060A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
LePage et al.

Application No.: 09/205,318

Group Art Unit: 3634

Filed: December 4, 1998

Examiner: Blair M. Johnson

For: ROLL-UP DOOR FOR VEHICLE SHELTERS

REPLY BRIEF

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Dear Sir:

This reply brief is being filed pursuant 37 C.F.R. §1.193(b) and is in response to the Examiner's Answer dated September 23, 2003.

I. RELATED APPEALS AND INTERFERENCES

The patent owner knows of no related appeals or interferences.

II. SUMMARY REVIEW OF ORIGINAL PROSECUTION HISTORY

Applicants appeal the rejection of claims 20-27. The Examiner acknowledges that these claims recite patentable subject matter, but rejects the claims as improper recapture under 35 U.S.C. §251. The patentability of claims 1-19 is not in question.

This broadening reissue application was filed by the patent owner on December 3, 1998. As indicated in the statement of error, the original application included a single claim directed to a roll-up closure device for use on a "door opening having lateral sides which diverge from top to bottom." The claim's preamble directly referenced this

particular environment of use, and certain claim elements were recited as having a shape substantially complementary thereto (e.g., a pair of guide means adapted to be mounted to the vehicle shelter “substantially at the lateral sides of the door opening and substantially parallel thereto” and a flexible closure having a shape “substantially complementary to that of the door opening and including diverging lateral side edges adapted to be engaged in said guide means”).

The Applicants amended this original claim only once, in response to a definiteness rejection under 35 U.S.C. §112. That rejection took issue with the Applicants’ decision to recite claim language in relation to a particular environment of use. The Applicants changed the closure recitation from reciting a complimentary shape to expressly reciting that the closure itself tapered (“a closure means having a shape which tapers in direction of said roller means,” amendment in underline).

The Applicants distinguished seven different patents in the remarks accompanying this amendment. Some distinctions mentioned the closure having a tapering shape. Others mentioned the prior art’s failure to teach the particular door opening environment then at issue. Still others mentioned entirely different features. A telephonic interview was held, and, a notice of allowance was mailed four days later. Along with that notice of allowance, the Examiner amended the guide means limitation to recite that the pair were adapted to be mounted at lateral sides of the door opening “substantially parallel thereto thereby diverging from top to bottom” (amendment in underline).

III. ARGUMENT

A. There Was No Surrender of Claim Scope.

The Examiner’s rejection and answer point to places in the prosecution history where the Applicants highlighted the tapering and diverging limitations as distinguishing

over the prior art. The Examiner's Answer states that the Applicants fully considered the tapering feature as rendering the original claims allowable. The patent owner does not dispute this statement, but does dispute the implication that the tapering feature is the only possible distinction of the invention over the prior art. The tapering feature, along with others, were highlighted by the Applicants in distinguishing the prior art. An applicant is fully entitled to highlight features it believes distinguish the prior art, and which were present in the originally-filed claim. How else would an applicant respond to an art rejection they deemed improper?

As provided in the Brief on Appeal and the remarks below, the recapture rejection is improper and unsustainable. Removal of the rejection and remand for allowance are respectfully requested.

1. The Subject Matter of Claims 20-27 was Not Examined or at Issue in the Original Prosecution.

It is undisputed that claims 20-27 recite patentably distinct subject matter. The Examiner has confirmed that these claims define over the prior art.

It is also undisputed that the subject matter of these claims was never under examination in the original prosecution. The tapering and diverging limitations in the issued claims were a direct result of the particular environment of use in the preamble. No claims directed to non-diverging door openings were ever introduced, and the Examiner does not argue the contrary. In fact, the tapering and diverging amendments added to the claims "were present in the originally filed patent claims in some form," per the Examiner's Answer. See, page 3.

Of course, with the present subject matter having never been in front of and examined by the Patent Office, it begs the question: How could the Applicants have surrendered such subject matter?

There is no indication that the Examiner ever contemplated the presently-sought subject matter. The Examiner's only description of the prior art spanned four lines:

4. Claim 1 is rejected under 35 U.S.C. §102(b) as being clearly anticipated by Belgian patent No. 53321.
5. Germann, Domecent, Lamb, Klose, Ojima et al and German patent No. 3841139 disclose pertinent closures.

The Examiner gave no specific description of the teachings of the prior art. The Examiner gave no indication whether the diverging or tapering limitations were considered within the prior art or not. One cannot fairly extract from the Examiner's few words the notion that broader subject matter was under examination or contemplated.

In response to the Examiner's naked prior art rejection, the Applicants chose remarks that highlighted the tapering features, as well as others that were present in the claims as filed. It is unfair and inequitable to now punish the Applicants for that choice.

2. There Are No Grounds Upon Which To Infer Surrender.

"The reissue statute is remedial in nature, based on fundamental properties of equity and fairness, and should be construed liberally." In re Doyle, 293 F.3d 1355, 1358 (Fed. Cir. 2002). As such, there can be no per se rule of recapture.

For example, the recapture rule does not apply if there is no evidence that the applicant's amendment was an admission that the scope of the prior claim was not patentable. Ex parte Eggert, 67 U.S.P.Q.2d 1716, 1725 (BPAI 2003). Furthermore, although deliberate cancellation or amendment of a claim in an effort to overcome a prior reference has been held to strongly suggest an admission of unpatentability, such amendment is not dispositive where other evidence in the prosecution history is to the contrary. Id. In short, even when a patentee has amended their claim in response to the prior art, a patentee may nonetheless seek broadening reissue.

The case law, albeit limited in number, is even more supportive of patentees seeking broadening reissue where the patentee has merely made remarks in distinguishing the prior art. For example, although surrender may occur through arguments alone, the Federal Circuit has set a very high threshold for such surrender, one that requires clear and unmistakable surrender. *See*, Brief on Appeal, §VII.B.1.

In the present appeal, the Examiner fails to provide any factual basis upon which surrender by argument could be found. The prosecution history is devoid of the repeated remarks that were the hallmark of the Hester decision. Brief on Appeal, §VII.B.2. There was a single response filed by the applicants, and the remarks in that response highlighted features chosen by the applicants, not features highlighted in any way by the Examiner. Furthermore, the prosecution history shows that numerous features were highlighted in distinguishing the issued claims over the prior art references.¹ And no feature was argued as critical.

Although the rejection now-appealed was based on argument-based surrender, the Examiner's Answer suggests that the claim amendments may also evidence surrender. First, the Applicants' amendments were made in response to a form rejection under 35 U.S.C. §112, not in response to a prior art rejection. The Examiner points to no case law that supports finding surrender in response to such a rejection. Second, the amendments served to overcome the form rejection by bringing language from the preamble into the claim body. The relationship between the claim limitations and the preamble was already set forth in original claim. This is undisputed, as the Examiner acknowledges that the tapering and diverging amendments added to the claims "were present in the originally filed patent claims

¹ See, also, Brief on Appeal, §VII.B.1. and Section III.B., at *infra*.

in some form.” Examiner’s Answer, p. 3. Thus, the amendments were clarifying amendments at best and did not represent a surrender of subject matter.

It is respectfully asserted that the Applicants’ formal amendments in response to the §112 amendment do not rise to the level of deliberate amendments that strongly suggest that the applicant admits the scope of the original claim is unpatentable. Consequently, there is no basis for inferring surrender based on the Applicants’ amendments, especially since the diverging or tapering limitations were already in the claims as filed. To infer such surrender would punish the Applicants for making an amendment in response to a §112 rejection by giving that formal amendment a prior-art-distinguishing effect.

Even the Examiner’s amendment to the issued claim is silent as to whether any claim scope excluding diverging and tapering limitations could be pursued. In fact, the Examiner’s amendment was absent any explanation and without any stated reasons for allowability.²

The Examiner states that it is implicit that he considered the diverging feature on the guide means as “the patentable feature” and that the Applicants agreed by their silence. The record does not support the notion that this feature was the patentable feature. Nevertheless, even if the Examiner’s amendment was motivated by the prior art, that is not the issue. The Examiner has not (and cannot) established that the existence of a (or the) patentable feature in a claim precludes a patentee from rightfully obtaining other claims absent that feature. The Board expressly rejected such logic in Ex parte Eggert and clarified that the question under reissue is whether subject matter was surrendered, not merely whether

² The potentially damaging effects of silence during prosecution caused the Federal Circuit in Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc. to state that it expected the PTO would henceforth usually include in the prosecution history express statements of its reasons for requiring or making claim changes or interpretive assertions. 141 F.3d 1161, 1163 (Fed. Cir. 1997).

the applicant seeks to retreat from the original grounds for patentability. Ex parte Eggert, 67 U.S.P.Q.2d at 1717. Moreover, surrender should be directed to the applicant's actions and the public record, not an examiner's un-memorialized reasons for allowance or interpretation of the prior art.

B. The Applicants' Statements Do Not Amount to Surrender.

Perhaps even more telling is the fact that the Applicants distinguished the prior art based on many different grounds, a point the Examiner's Answer fails to acknowledge in any way.

The Applicants, for example, distinguished the Klose, Ojima et al., and Germann patents for failing to teach closing-off an entire opening. The Applicants even acknowledged that the Klose patent taught trapezoidal coverings, i.e., structures with tapered sides. Yet, the Klose patent was distinguished because its coverings were not closures. The Ojima et al. and Germann patents were also distinguished because they taught rollers at the bottom of an opening, a configuration incompatible with a vehicle shelter. For the Examiner to suggest now that the "diverging sides of the closure and the diverging guide means are the primary, and essentially only, feature which renders the claims allowable" is contrary to the prosecution history.

C. The Examiner Attempts to apply a Per Se Rule against Broadening Reissue That Has Been Rejected by the Board in Ex parte Eggert.

The Examiner's recapture rejection reduces to little more than a per se rule that any claim limitation argued to distinguish over the prior art may never be removed through broadening reissue. In so doing, the Examiner falls into the per se trap denounced by the Board in Eggert. There, the Board made clear that "the focus for determining the reach of the reissue recapture rule should be the claim from which the issued claim directly evolved, not the issued claim itself." Ex parte Eggert, 67 U.S.P.Q.2d at 1718. The Board confirmed

that there is no per se rule against obtaining a claim that excludes limitations that have been added to a claim or argued by an applicant during prosecution in order to overcome a rejection and obtain a patent. *Id.* at 1723. The Board in Eggert expressly rejected the notion that the Pannu v. Storz Instruments Inc.³ decision cited by the Examiner's Answer mandates a per se rule against removing claim limitations that were relied upon to affect allowance.

Simply put, the Examiner's per se rule attempts to vitiate the decision in Eggert, and this should not be allowed. The Board in Eggert illustrated (*see*, Drawing 1) how to analyze the question of impermissible recapture. The Eggert decision confirmed that broadening may occur between the issued subject matter (i.e., the inner circle) and the surrendered subject matter (i.e., the outer circle). This permitted region is the shaded area of Eggert and is created by the applicants seeking broader subject matter and retreating from it. Yet, in the instant case, there is no originally-presented broader subject matter. There is no outer circle. There is no inner circle. They are the same. The Examiner cannot point to any place in the prosecution history where the presently-sought subject matter was ever at issue. Without any suggestion from the prosecution history that the presently-sought subject matter was at issue and surrendered, there can be no impermissible recapture.

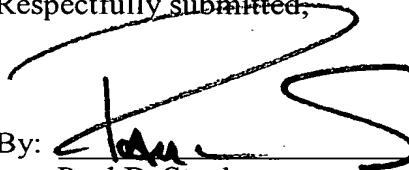
³ 258 F.3d 1366 (Fed. Cir. 2001).

IV. CONCLUSION

In short, the Applicants did not surrender the presently-sought subject matter during the original prosecution. There is nothing in the record that suggests that this subject matter was at issue or even contemplated. There is no suggestion from the prosecution history that the amendments to the claims surrendered the presently-sought subject matter, either. The issued claims were directed to a particular environment of use present in the claims as originally filed. Furthermore, there is no suggestion that the remarks of the Applicants, remarks that focused on tapering limitations and others, rose to the level of clear and unmistakable surrender required for argument-based surrender. The recapture rejection is improper and should be removed.

Dated: November 24, 2003

Respectfully submitted,


By: _____

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